

REMARKS

Upon entry of this Reply, claims 2-11 will be pending. Claims 2-6 will have been amended to clarify Applicants' claimed subject matter. Claims 7 and 8 stand withdrawn with traverse for the reasons indicated in Applicants' paper filed January 9, 2006, thereby retaining their right to petition from the requirement under 37 C.F.R. § 1.144. And, new claims 9-11 will have been added to afford the Applicants a scope of protection commensurate with an aspect of their invention.

Applicants note with appreciation the Examiner's consideration of the documents cited in the Information Disclosure Statement filed July 15, 2004 in the present application. Applicants thank the Examiner for returning, with the afore-noted Office Action, an initialed and signed copy of the PTO-1449 Form that accompanied the July 15, 2004 Information Disclosure Statement.

Applicants respectfully request that the Examiner consider and acknowledge, in the next Office communication, Applicants' foreign priority claim under 35 U.S.C. §119(a)-(d). As noted in Applicants' Declaration and Power of Attorney (filed concurrently with the above captioned Application), Applicants claim priority from Japanese patent application No. 2003-119143 (filed April 24, 2003). A review of the U.S. Patent and Trademark Office (USPTO) "PAIR" system reveals that the USPTO has properly recorded Applicants' foreign priority claim, as well as received and recorded a certified copy of the Japanese patent application priority document (*i.e.*, application no. 2003-119143). Thus, the Examiner is respectfully requested to consider and acknowledge Applicants' claim for priority under 35 U.S.C. §119, and to confirm receipt

of the certified copy of the above noted priority document in the next Office communication.

In the afore-noted Office Action, the Examiner objected to the abstract of the disclosure for being 16 lines. The Examiner cited MPEP §608.01(b). The Applicants request reconsideration and withdrawal of this objection.

Initially, the Applicants wish to express their gratitude to the Examiner for the Examiner's careful attention to detail in examining the present application. Referring to MPEP § 608.01(b), the section states that "[t]he abstract should not exceed 15 lines of text. Abstracts exceeding 15 lines of text should be checked to see that it does not exceed 150 words in length." The Applicants have checked the abstract and found it to be 146 words in length. Therefore, the abstract is compliant with MPEP §608.01(b). Thus, Applicants respectfully request reconsideration and withdrawal of the objection to the abstract of the disclosure.

In the afore-noted Office Action, the Examiner rejected claims 1-6, under 35 U.S.C. § 112, second paragraph as being indefinite. After having considered the Examiner's remarks, Applicants have cancelled claim 1 (which has been substantially rewritten as new claim 9), and amended claims 2-6 to more clearly define the claimed subject matter. Applicants submit new claims 9-11 for the Examiner's consideration. Applicants submit that claims 2-11 are fully compliant with Section 112, second paragraph. Applicants respectfully request reconsideration and withdrawal of the outstanding rejection of claims 2-6 (claim 1 having been canceled upon entry of this Reply) under § 112, second paragraph, and timely allowance of all pending claims.

Also in the afore-noted Office Action, the Examiner rejected claims 1-6, under 35 U.S.C. § 102(b) as being anticipated by TANAKA et al. (U.S. Patent No. 5,541,910). Applicants respectfully traverse this rejection and request withdrawal of the same.

Referring to claim 9, the claim recites *inter alia* “a recording medium preform comprising . . . a second cavity formed in the first surface at a position corresponding to the first cavity, the second cavity being formed on either side of a part to be punched out, wherein the second cavity comprises a first concave portion formed in a planar ring form, the first concave portion comprising: a first inner wall surface whose diameter is substantially equal to a diameter of an inner wall surface of the first cavity; and a base surface substantially transverse with the first inner wall surface.” Applicants respectfully submit that TANAKA et al. do not teach or suggest, alone or in any proper combination, the noted recitation of claim 9.

Referring to Figures 1 and 2 of TANAKA et al., the reference teaches an optical disc with an inner circular projection portion 22, that includes a cylindrical projection 23. Circular projection portion 22 has a hole with two different diameters as shown in FIG. 1. One portion of the hole has a radius  $r_1$ , and the other has a radius of  $r_2$ .

However, a review of the entire TANAKA et al. patent reveals that the reference fails to teach or suggest, for example, a recording medium preform or a ring shaped concave portion as recited in claim 9. Instead, TANAKA et al. teach a final product optical disk (**not** a preform) that has a clamp 4 affixed to a substrate 1. Likewise, TANAKA et al. do not teach “a second cavity formed in the first surface at a position corresponding to the first cavity, the second cavity being formed on either side of a part to be punched out, wherein the second cavity comprises a first concave portion formed

in a planar ring form, the first concave portion comprising: a first inner wall surface whose diameter is substantially equal to a diameter of an inner wall surface of the first cavity; and a base surface substantially transverse with the first inner wall surface" as recited in claim 9, for example.

Thus, because TANAKA et al. do not teach each and every element of Applicants' claimed embodiments, Applicants respectfully request withdrawal of the rejection of claims 1-6, under 35 U.S.C. §102(b) set forth in the outstanding Office Action mailed March 3, 2006, and allowance of all pending claims.

More so, Applicants believe they have overcome all outstanding rejections by this Reply and that the application is ready for allowance. Thus, Applicants respectfully request reconsideration and withdrawal of all outstanding rejections and timely allowance of claims 2-11.

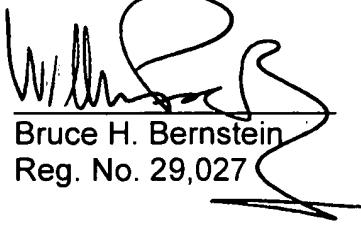
SUMMARY AND CONCLUSION

In view of the foregoing, it is submitted that Examiner's rejections under 35 USC §§102 and 112, second paragraph, in the Office Action dated March 3, 2006, should be withdrawn. The present Reply is in proper form, and none of the cited prior art teach or suggest Applicants' claimed invention. In addition, the applied reference of record has been discussed and distinguished, while significant features of the present invention have been pointed out. Accordingly, Applicants request timely allowance of the present application.

Applicants note that this Reply is being made to advance prosecution of the application to allowance, and no acquiescence as to the propriety of the Examiner's rejections is made by the present Reply. All amendments to the claims which have been made in this Reply, and which have not been specifically noted to overcome a rejection based upon the prior art, should be considered to have been made for a purpose unrelated to patentability, and no estoppel should be deemed to attach thereto.

Should there be any questions regarding this paper or the present application, the Examiner is respectfully requested to contact the undersigned at the below-listed telephone number.

Respectfully submitted,  
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